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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,082	03/25/2004	Jin-Won Jung	04019.00048	7668
22908 7590 04/04/2007 BANNER & WITCOFF, LTD. TEN SOUTH WACKER DRIVE SUITE 3000 CHICAGO, IL 60606			EXAMINER WYSZOMIERSKI, GEORGE P	
			ART UNIT 1742	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/04/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/809,082

Applicant(s)

JUNG ET AL.

Examiner

George P. Wyszomierski

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 17-33 is/are pending in the application.
- 4a) Of the above claim(s) 18-28 and 31-33 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 29 and 30 is/are allowed.
- 6) ☒ Claim(s) 1-3 and 8-10 is/are rejected.
- 7) ☒ Claim(s) 4-7, 11-15 and 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. The amendment filed February 12, 2007 has been entered. The amendment clearly overcomes the rejections under 35 USC 112 made in the previous Office Action.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1, 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Koizumi et al. Materials Science and Engineering article.

Koizumi discloses a nickel-titanium-aluminum shape memory alloy having a composition as claimed and including a parent phase and a β' phase dispersed therein. Koizumi does not specify the amount of misfit created by the dispersed phase and does not specify the chemical equilibrium temperature of the alloy. However, these features of the claimed invention would appear to be a result of the composition and processing history of a given alloy. Because these factors may be the same in both the Koizumi materials and those as claimed, a prima facie case of obviousness is established between the disclosure of Koizumi et al. and the presently claimed invention.

4. Claims 1, 2, 3, 8, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Jung et al. Met.Trans. A article. It is noted that this publication is "by another" because the prior art article includes two authors who are not inventors of the present application.

Jung discloses NiTiAlX shape memory alloys (where X= Hf or Zr, specifically 5 at % of Hf or Zr) having a composition as presently claimed, and including a Heusler phase precipitated in a parent B2 phase and having a misfit amount within the range as presently claimed. Jung does not disclose the shape of the parent phase upon stress and unloading as presently claimed and does not specify the chemical equilibrium temperature of the alloy. However, these features of the claimed invention would appear to be a result of the composition and processing history of a given alloy. Because these factors may be the same in both the Jung materials and those presently claimed, a prima facie case of obviousness is established between the disclosure of Jung et al. and the presently claimed invention.

5. In a response filed February 12, 2007, Applicant alleges that the Koizumi materials are not shape memory alloys as required by the instant claims, and/or that the Jung reference (which includes the present inventors as co-authors) is inapplicable because it was published less than one year prior to filing of the present application. Applicant's arguments have been carefully considered, but are not persuasive of patentability because:

a) With respect to Koizumi, the bottom left-hand corner of page 36 of the reference specifically states that the materials under discussion in the prior art "have been known as shape-memory alloys."

b) With regard to Jung, Applicant states that the other named authors of Jung were not inventors, but merely "individuals who performed services at the direction and within the control and supervision of the inventors." Applicant may thus overcome the rejection by providing a declaration under 37 CFR 1.132 to that effect. See MPEP section 716.10 and *In re Katz* (215 USPQ 14, CCPA 1982).

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6. Claims 29 and 30 are allowable over the prior art of record, and Claims 4-7, 11-15 and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

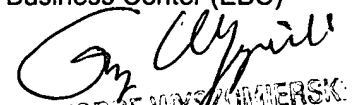
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Wyszomierski whose telephone number is (571) 272-1252. The examiner can normally be reached on Monday thru Friday from 8:00 a.m. to 4:30 p.m. Eastern time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King, can be reached on (571) 272-1244. All patent application related correspondence transmitted by facsimile must be directed to the central facsimile number, (571)-273-8300. This Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GPW
April 2, 2007


GEORGE WYSZOMIERSKI
PRIMARY EXAMINER
GROUP 1700